

REMARKS

Accompanying this response are a full set of Replacement sheet drawings -- drawings that are identical to the original drawings, but with the lines, numerals and legends thereof inked to render the drawings "formal." Acceptance of the Replacement Sheet drawings is respectfully requested.

This response takes into account what has been discussed by counsel with Examiner Laura Edwards (at a time after the Examiner considered and refused entry of a previously proposed Amendment After Final Rejection). It is believed that this response puts Claims 1-42 and 44-48 in good form for prompt allowance inasmuch as Claims 1, 17, 24 and 40 are amended herewith to add (at the ends of Claims 1, 17, 24 and 40) slightly less than two dozen words for the purpose of introducing into Claims 1, 17, 24 and 40 a limitation that previously was found in Claim 43 (a limitation that was deemed by the Examiner to render Claim 43 allowable). And, Claim 43 has been cancelled inasmuch as its subject matter has been added to Claim 40.

Other reasons why Claims 1, 17, 24 and 40 also are believed by Applicant to be allowable are described in the paragraphs that follow. Reconsideration and allowance of Claims 1-42 and 44-48 are respectfully solicited in view of the amendments and remarks presented herewith, in view of the submission of Replacement Sheet drawings herewith, and in view of what is believed to be an agreement reached with the Examiner about the adequacy of the limitation being added to Claims 1, 17, 24 and 40 herewith.

Applicant acknowledges with appreciation the Examiner's indication that Claims 10 and 14 will be allowed if antecedent concerns are addressed. With this response, Claims 10 and 14 have been amended to address those concerns. In view of the amendments presented herewith, it is urged that Claims 10 and 14 (and such

claims as depend therefrom) are now in good form for prompt allowance. Other 35 USC 112 concerns raised by the Examiner regarding Claims 1, 17, 24 and 40 are addressed by the amendments made to these claims.

Amendments made herewith to Claims 1, 17, 24 and 40 place better emphasis on the fact that Applicant's claimed paint shield protectively covers a "downwardly facing front face of a lens of a lighting fixture"<sup>1</sup> by utilizing a "relatively stiff material that resists sagging under the influence of gravity,"<sup>2</sup> that is sufficiently "pliable to permit central portions thereof to flex away from the front face of the lens" so that other portions can be inserted between an "upwardly facing surface of a frame"<sup>3</sup> and portions of the front face of the downwardly facing lens to thereby "hold the paint shield in place" during painting of the frame.

Although Applicant's and Panitzsch's paint shields are both intended to protectively cover areas that are not to be painted during painting of adjacent areas, Applicant's and Panitzsch's paint shields nonetheless serve very different purposes and cannot be used

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<sup>1</sup>No "new matter" issues are raised by the inclusion in Claims 1, 17, 24 and 40 of language calling for a "downwardly facing front face" inasmuch as this language finds support in Applicant's specification at page 12, line 22, et seq.

<sup>2</sup>No "new matter" issues are raised by the inclusion in Claims 1, 17, 24 and 40 of the language "resists sagging under the influence of gravity" inasmuch as this language finds support in Applicant's specification at page 13, line 12, et seq.

<sup>3</sup>No "new matter" issues are raised by the inclusion in Claims 1, 17, 24 and 40 of the language "upwardly facing surface" inasmuch as this language finds support in Applicant's specification at page 12, line 24, et seq.

interchangeably. As is stated at the beginning of Applicant's specification:

The present invention relates to paint shields formed from relatively stiff but pliable material configured to protectively cover the transparent or translucent lenses of light fixtures so that frame components of the fixtures which extend perimetrically about the lenses can be painted by brush, by roller or by spray without getting paint on the lenses.

This is quite different from the purpose served by the paint shield of Panitzsch, which, as stated in lines 42-46 of page 1, is "to protect the frame against having paint or other decorative material applied to the frame during application thereof to the walls surrounding the frame." In other words, Applicant's paint shield permits the frame surrounding a protected area to be painted, while Panitzsch shield prevents the frame that surrounds the protected area from being painted (i.e., Panitzsch includes the frame in the area that is to be protected from being painted).

To permit the frame surrounding a protected area to be painted, Applicant's paint shield is designed to have its edge portions inserted behind portions of the frame (i.e., between upwardly facing portions of the frame and peripheral portions of the downwardly facing lens) that surround the protected area. Applicant's paint shield permits paint to be applied to the entire front face of a frame that surrounds an area to be protected from painting so that the juncture between what becomes painted and what is protected is defined by the inner edge of the frame.

To prevent the frame that surrounds a protected area from being painted, edge portions of the shield of

Panitzsch extend across, overlies and are nailed into the front face of the frame that surrounds the protected area. Panitzsch's paint shield is nailed in place atop the front face of a frame so that the juncture between what becomes painted and what is protected is defined by the outer edge of the frame.

This significant difference in purposes is necessarily related to a significant difference in orientation in which Panitzsch's and Applicant's paint shields are installed when used. Panitzsch essentially discloses a paint shield that is intended to be installed in a vertical mode that allows the material of Panitzsch's paint shield to be flexible enough for Panitzsch's paint shield to be rolled up for compact transport and storage. The Panitzsch patent does not teach a paint shield that is made of a material that is stiff enough to avoid sagging under the influence of gravity, which is a requirement of Applicant's paint shield, which is necessarily installed in a horizontal orientation when portions of Applicant's paint shield are inserted between peripheral portions of a "downwardly facing front face of a lens" and an "upwardly facing surface of a frame."

Whereas Panitzsch's paint shield is able to make use of the influence of gravity to maintain its vertical orientation, Applicant's paint shield must resist the influence of gravity to maintain its horizontal orientation; and when the requirement that portions of Panitzsch's paint shield are able to be rolled up is taken into account, it becomes clear that Panitzsch's and Applicant's paint shields require materials of differing characteristics.

An honest reading of Panitzsch reveals that the one and only disclosed means of holding Panitzsch's paint shield in place when installed is nailing pins into a frame to be covered. There is no teaching or suggestion

of any other means of holding the Panitzsch paint shield in place when installed, and so there is no teaching or suggestion of edge portions of the Panitzsch's paint shield being inserted between an "upwardly facing surface of a frame" and peripheral portions of a "downwardly facing surface of a lens" so as to extend between a frame and the lens to be held in place therebetween. Indeed, there is no teaching or suggestion in Panitzsch of inserting any portion of Panitzsch's paint shield between any two objects of any kind or for any reason.

Applicant respectfully traverses the Examiner's assertion about the removability of the so-called "pin strip" of Panitzsch. A careful reading of Panitzsch reveals that it would be necessary to destroy Panitzsch's paint shield to remove the "pin strip" from Panitzsch's paint shield. This is because the pins 15 are carried by members 11, 12, which are permanently attached to flexible shields 16, 17 (the Examiner's attention is respectfully drawn to lines 4-12 of page 2 describing a permanent connection to "bind" each of members 11, 12 to corresponding ones of flexible shields 16, 17 "against separation"). Just as there is no teaching or suggestion to use any form of installing Panitzsch's paint shield in place other than by nailing pins into a frame, there is no teaching or suggestion to tear apart the permanent connections between the members 11, 12 and corresponding ones of flexible shields 16, 17.

Because independent Claims 1, 17, 24 and 40, as amended herewith, clearly bring out significant differences in construction, choice of material and use between the Panitzsch paint shield and Applicant's claimed invention, as discussed above, it is urged that the 35 USC 103 rejections of independent Claims 1, 17, 24 and 40 (and the claims that depend therefrom and against which the same

rejections have been made) be reconsidered and withdrawn, and that all of the active claims be allowed.

Moreover, as has been discussed with the Examiner by telephone, Claims 1, 17, 24 and 40 also have been amended to include a limitation previously found in Claim 43 (a claim that now has been cancelled) -- as by adding to each of Claims 1, 17, 24 and 40 the following words:

and wherein one of the paint shield elements is provided with a stiffening formation extending across at least a selected portion thereof.

The words added to Claims 1, 17, 24 and 40 were discussed with Examiner Laura Edwards by telephone and are understood to have met with the Examiner's approval. Just as the inclusion in Claim 43 of words calling for "a stiffening formation extending across at least a selected portion of one of the paint shield elements" was deemed by the Examiner to render Claim 43 allowable, the addition of the substantially equivalent words that are set out just above should be deemed by the Examiner to render Claims 1, 17, 24 and 40 allowable. Counsel understands from his telephone conversation with the Examiner that the Examiner is in agreement, and that the amendments made herewith to Claims 1, 17, 24 and 40 put these claims in good form for prompt allowance.

It is believed that the addition of the words set out just above to Claims 1, 17, 24 and 40 requires no changes to claims that depend directly or indirectly from Claims 1, 17, 24 and 40 -- other than the cancellation of Claim 43, which is attended to herewith.

If the Examiner should find any remaining issues or concerns that perhaps can be resolved by telephone, the Examiner is encouraged to call the undersigned attorney, for counsel will gladly cooperate with the Examiner in any

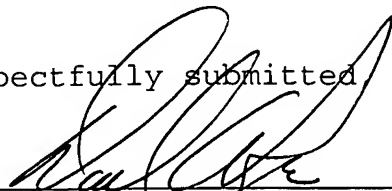
reasonable way that will advance the prosecution of this case to successful conclusion.

Respectfully submitted

10/25/05

Date

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